

REMARKS

In the Office Action¹ mailed July 7, 2010, the Examiner rejected claims 1, 2, 5, 6, 11-17, 20, 21, 23-25, 27, 45-51 and 54-59 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,005,945 to Whitehouse ("*Whitehouse*") in view of U.S. Patent No. 5,019,991 to Sansone ("*Sansone*") and in view of U.S. Patent No. 7,458,612 to Bennett ("*Bennett*"), and rejected claims 52-53 under 35 U.S.C. § 103(a) as being unpatentable over *Whitehouse*, *Sansone*, and *Bennett* in view of Official Notice.

By this response, Applicants have amended claims 1, 11, 20, and 24. No new matter has been added. Claims 1, 2, 5-8, 11-21, 23-25, 27, 28, 30, 31, and 33-59 are pending, with claims 7, 8, 18, 19, 28, 30, 31, and 33-44 withdrawn, and claims 3, 4, 9, 10, 22, 26, 29, 32 cancelled. Thus, claims 1, 2, 5, 6, 11-17, 20, 21, 23-25, 27, and 45-59 under current examination.

Rejection of Claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the above rejections of the pending claims under 35 U.S.C. § 103(a). *A prima facie* case of obviousness has not been established with respect to the claims as amended.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. §

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established at least because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art.

Claim 1 recites, among other things,

printing, using a printing device, a postage indicia that represents the estimated postage amount, an addressee information, a sender information, a unique postage number that uniquely identifies the postage indicia and prevents duplication of the postage indicia, a unique delivery confirmation number that uniquely identifies the mailpiece, and a date,

wherein the postage indicia represents the estimated postage amount in a format readable by machine only, and

wherein at least one of the unique postage number and the unique delivery confirmation number is associated with billing information of a sender that identifies an account of the sender.

The Office Action correctly states that no combination of *Whitehouse* and *Sansone* discloses these elements of claim 1. O.A. at 6.

Bennett fails to cure this defect of *Whitehouse* and *Sansone*. The Office Action alleges that the postage value of *Bennett* constitutes the claimed billing information. O.A. at 3, 6. However, this is not correct. The postage value of *Bennett* cannot constitute the claimed billing information of a sender because the postage value of *Bennett* does not identify an account of the sender. Therefore, *Bennett* does not disclose or suggest at least “wherein at least one of the unique postage number and the unique delivery confirmation number is associated with billing information of a sender that identifies an account of the sender,” as recited by amended claim 1.

Official Notice also fails to disclose at least this element of amended claim 1. The Office Action cited Official Notice for disclosing the conversion of “human readable strings into formats readable by machine only such as barcodes.” O.A. at 16. Even assuming the Official Notice is properly taken, which Applicants do not concede, Official Notice fails to cure the deficiencies of *Whitehouse*, *Sansone*, and *Bennett*, discussed above. That is, Official Notice does not disclose or suggest “wherein at least one of the unique postage number and the unique delivery confirmation number is associated with billing information of a sender that identifies an account of the sender,” as recited by amended claim 1.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. Moreover, the Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at

least this reason, no *prima facie* case of obviousness has been established. The rejection of claim 1 under 35 U.S.C. § 103 as being obvious from *Whitehouse* in view of *Bennett* is thus improper and should be withdrawn.

Although of different scope, independent claims 11, 20, and 24 include elements similar to those discussed above. For at least the same reasons presented above in connection with the patentability of claim 1, the Office Action does not establish a *prima facie* case of obviousness with respect to independent claims 11, 20, and 24. Accordingly, these claims are patentable over the cited references and, thus, are allowable. Applicants respectfully request that the Examiner withdraw the section 103 rejection of claims 11, 20, and 24.

Dependent claims 2, 5, 6, 12-17, 21, 23, 25, 27, and 45-59 are also nonobvious at least by virtue of their dependence from nonobvious independent claims, as well as by virtue of reciting additional elements not taught or suggested by the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 2, 5, 6, 12-17, 21, 23, 25, 27, and 45-59 under 35 U.S.C. § 103(a) and issue a Notice of Allowance for all pending claims.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any additional extensions of time required to enter this response
and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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